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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/008,600

12/04/2001

Dirk Voelkel

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2473

7590

07/12/2004

Roche Diagnostics Corporation
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EXAMINER

ROSENBERGER, RICHARD A


ART UNIT

PAPER NUMBER

2877

DATE MAILED: 07/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application N . 10/008,600	Applicant(s) VOELKEL, DIRK	
	Examiner Richard A Rosenberger	Art Unit 2877	

-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04/13/2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2877

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 15-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jina et al (US 5,526,120).

The reference shows a system and method for analyzing sample liquids by evaluating test elements (test strips) with an analytical unit in which the test element to be analyzed is positioned in a holder in an analytical position relative to the analytical instrument. The system comprises a position control unit to check whether the test element is correctly positioned relative to the analytical unit; see figures 9-14 of the reference in particular. The position control unit comprises a light source to illuminate an area on the test element and detector to detect light reflected from the illuminated area of the test element (column 13, lines 38-39; column 14, lines 22-25). There is an evaluation unit which uses the intensity of reflected light to determine if the test element is correctly positioned or not (column 13, lines 60-65; column 14, lines 1-5 and lines 32-42).

Independent claim 15 includes the language that the detected light is "specularly reflected"; Jina et al does not use this term, and does not have a particular discussion of the relative angle of the detected light. However, as seen in

figure 13, what is illustrated appears to be specularly reflected light, and nothing in the disclosure of the patent suggests that it is not. What is of importance to the operation is that the detector “sees” different amounts of reflected light when the test element is and is not in proper position; placing the light source and detector in a position in which the light is specularly reflected, that is, the angles of illumination and detection are equal and opposite, as illustrated in figure 13, would have been obvious.

Independent claim 26, as amended, calls for indicating to a user whether the analytical area is positioned correctly. Jina et al teaches “preferably” reporting the incorrect position of the test element to a user (column 13, lines 17-18 and lines 62-65, and column 14, lines 3-5). Given the teaching that reporting the error to a user is preferably done, it is at least obvious to do it.

The reference teaches that either high or low intensity of reflected light can be used as indicative of correct placement of the test element (column 13, lines 31-35 taken with column 14, lines 6-12, and column 14, lines 43-48).

The reference uses the disclosed position control unit in an analytical instrument in which the test element is analyzed using light reflected from an analytical area of the test element. The position control unit could be arranged to illuminate the test element and any convenient location and angle at which there is sufficiently high difference in response to indicate correct positioning. The reference teaches using a microprocessing means to control the system (column 13, lines 51,

Art Unit: 2877


61), column 14, line 3) which may be a microprocessor (column 14, line 41); having microprocessor check the proper positioning of the strip before it takes the measurement would have been obvious, since if the strip is improperly positioned the reading would be erroneous.

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard A Rosenberger whose telephone number is (571) 272-2428. The examiner can normally be reached on Monday through Friday during the hours of 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frank Font can be reached on (571) 272-2415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

R. A. Rosenberger
8 July 2004



Richard A. Rosenberger
Primary Examiner